



Attorney's Docket No. 1011350-000276

1/11
AF-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Takeo Katsuda) Group Art Unit: 2145
Application No.: 09/880,039) Examiner: THOMAS DUONG
Filed: June 14, 2001) Appeal No.: _____
For: APPARATUS, PORTABLE)
TERMINAL UNIT, AND SYSTEM)
FOR CONTROLLING E-MAIL,)
AND ITS METHOD, COMPUTER-)
READABLE RECORDING)
MEDIUM AND PROGRAM)
PRODUCT FOR PROCESSING)
E-MAIL)

APPEAL BRIEF

Mail Stop APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This appeal is from the decision of the Primary Examiner dated March 21, 2008 rejecting claims 14, 31, 38, 40, 42 and 44-46 which are reproduced as the Claims Appendix of this brief.

☐ A check covering the ☐ \$ 250 ☐ \$ 500 Government fee is filed herewith.

☒ Charge ☐ \$ 250 ☒ \$ 500 to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

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I. Real Party in Interest

The present application is assigned to Minolta Co., Ltd.. Minolta Co., Ltd. is the real party in interest.

II. Related Appeals and Interferences

The Appellant's legal representative, or assignee, does not know of any other prior or pending appeals, interferences, or judicial procedures, which will affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

III. Status of Claims

The application contains claims 1-47. Claims 1-13 and 32-36 have been canceled. Claims 14-31 and 37-47 are pending. Claims 14, 31, 38, 40, 42 and 44-46 stand rejected. Claims 15-30, 37, 39, 41, 43 and 47 have been allowed. This appeal is directed to the rejections of claims 14, 31, 38, 40, 42 and 44-46.

IV. Status of Amendments

No Amendments have been filed since the Office Action dated March 21, 2008.

V. Summary of Claimed Subject Matter

The independent claims are generally directed to an e-mail controlling apparatus and e-mail controlling system, an e-mail processing method, a computer readable medium and a program product and an e-mail controlling apparatus.

Appellant's Figure 3 is a conceptual diagram for describing the various functions performed by the claimed embodiments. As described at paragraphs [0045]-[0054], an e-mail receiving module 121 and an e-mail sending module 122 are software modules for, respectively, receiving and sending e-mails according to a conventional protocol similar to an existing mail server. An e-mail analysis module 123 is a software module for determining whether e-mail has been received from another mail server, has any attachments, and for extracting the attached files. In

addition, the e-mail analysis module 123 extracts the instruction parts of telephone numbers and IP addresses contained in the e-mail. An e-mail editing module 124 prepares a receipt notice e-mail. Specifically, the receipt notice e-mail is prepared by removing the attachment file portion from the received e-mail, and adding the fact that the attachment file portion is removed as well as the name and type of the attachment file that has been removed (paragraph [0050]). A format or type conversion module 125 converts the e-mail into a format that can be output by a selected image output device. Image output devices 950, 960 and 970 are shown in Figure 1.

Also disclosed is a portable telephone position acquisition module 126 for acquiring the current location of a portable telephone for receiving e-mail via the network and the telephone network. A location information registration module 127 registers and stores the location information of multiple image output devices by the type of device (paragraph [0052]). An output search module 128 selects the image output device to which the entire e-mail received by the mail server 100 and/or the data that corresponds to the attachment file is output.

A mapping of each of the appealed independent claims to a representative portion of the disclosure is set forth in the following claim charts.

Claim	Disclosure
14. An E-mail controlling apparatus comprising:	Paragraph [0044], Mail Server 100, Fig. 2
an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;	The software module described in Paragraph [0045] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051]
an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;	The software module described in Paragraph [0047] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051]
an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail	The e-mail sending software module described in Paragraph [0045] as

prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;	executed by Mail Server 100 of Fig. 1, or described in paragraph [0051]; Fig. 3
an instruction receiving device receiving an E-mail including an instruction for specifying one of multiple image output devices;	Mail server 100, Fig. 1, Step S205, Fig. 5 and Paragraph [0062]; Fig. 3
a converting device converting the attachment file portion into data of a format acceptable to the image output device; and	The software module described in Paragraph [0048] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051]
a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.	The software module described in Paragraphs [0045], [0048] as executed by Mail Server 100 of Fig. 1, or described in paragraph [0051]; Fig. 5
31. An E-mail controlling system comprising:	Figs. 1-3, and 5, Paragraphs [0051], [0053] and [0056].
an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;	Fig 8, Paragraph [0071]
an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;	Mail server 100, Fig. 2 Paragraph [0074]
an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;	Mail server 100, Fig. 2 Paragraphs [0053] and [0058]
an instruction receiving device receiving an E-mail including an instruction specifying one of multiple image output devices;	Mail server 100, Fig. 2; Paragraphs [0053] and [0065]

a converting device converting the attachment file portion into data of a format acceptable to the image output device; and	Mail server 100, Fig. 2; Paragraphs [0051], [0056] and [0066]
a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.	Mail server 100, Fig. 2; Paragraph [0066]
38. An E-mail processing method comprising the steps of:	Figs. 6 and 7
receiving E-mail addressed to a certain destination;	Figs. 6 and 8, Paragraph [0070]
preparing receipt notice E-mail based on the received E-mail;	Paragraph [0074]
transmitting said receipt notice E-mail to said destination;	Fig. 7, step S311, Paragraph [0090]
acquiring location information of said destination;	Paragraph [0079]
selecting one of multiple image output devices on the basis of the location information of said destination acquired;	Fig. 6, step S306, Paragraph [0082]
sending an E-mail to said destination containing a notification of the selected image output device; and	Fig. 7, step S319, Paragraph [0097]
transmitting at least a portion of the data of the received E-mail to the selected image output device.	Fig 7, S318 Paragraph [0096]
40. A computer-readable medium having a plurality of sequences of instructions stored thereon including sequences of instructions which are executed by one or more processors to perform the steps of:	Figs. 6 and 7, Paragraph [0145]
receiving E-mail addressed to a certain destination;	Figs. 6 and 8, Paragraph [0070]
preparing receipt notice E-mail based on the received E-mail;	Paragraph [0074]

transmitting said receipt notice E-mail to said destination;	Fig. 7, S311 Paragraph [0090]
acquiring location information of said destination;	Paragraph [0079]
selecting one of multiple image output devices on the basis of the location information of said destination acquired;	Fig. 6, S306 Paragraph [0082]
sending an E-mail to said destination containing a notification of the selected image output device; and	Fig. 7, S319 Paragraph [0097]
transmitting at least a portion of the data of the received E-mail to the selected image output device.	Fig. 7, S318 Paragraph [0096]
42. A program product comprising:	Paragraph [0145]
a computer-readable medium; and	Paragraph [0145]
computer program contained on said computer-readable medium for causing a computer to execute a process comprising the steps of: receiving E-mail addressed to a certain destination;	Figs. 6 and 7, Paragraph [0145]
preparing receipt notice E-mail based on the received E-mail;	Paragraph [0074]
transmitting said receipt notice E-mail to said destination;	Fig. 7, step S311 Paragraph [0090]
acquiring location information of said destination;	Paragraph [0079]
selecting one of multiple image output devices on the basis of the location information of said destination acquired;	Fig. 6, step S306, Paragraph [0082]
sending an E-mail to said destination containing a notification of the selected image output device; and	Fig. 7, step S319 Paragraph [0097]
transmitting at least a portion of the data of the received E-mail to the selected image output device.	Fig. 7, step S318, Paragraph [0096]
44. An E-mail controlling apparatus comprising:	Mail server 100, Figs. 1 and 2

a communication interface for sending and receiving E-mails;	Fig. 2, element 170, Paragraphs [0040] - [0042], [0044],and [0046]
a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail and information on at least one output device to which at least a part of the E-mail is to be outputted, and for controlling the communication interface to send the generated one E-mail to said certain destination.	Fig. 2, element 110 Paragraphs [0044], [0045], and [0054]

VI. Grounds of Rejection to be Reviewed on Appeal

Claims 14 and 31 were rejected under 35 U.S.C. § 102(e) as being anticipated by Miller et al. (US006421707B1).

Claims 38, 40, 42 and 44-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Theimer et al. (US005493692).

VII. Argument

A. Rejection Under 35 USC § 102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claims 14 and 31

Independent claims 14 and 31 recite, in combination with other features, an E-mail transmitting device transmitting to said portable terminal unit a receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices.

In rejecting claims 14 and 31, the Examiner asserts that this claimed subject matter is disclosed in the Miller patent at column 1, lines 52-55 and column 9, lines 41-46, (Office Action at pg. 4, first bullet). The Examiner comments that the Miller patent "teaches of an environment where a receipt notification is generated and delivered to an addressee."

However, the claimed feature of an E-mail identifying multiple prospective image output devices is not disclosed. Nor is it addressed in the rejection. The Miller patent does not describe the claimed step of transmitting an E-mail identifying multiple prospective image output devices. It only discloses the selective sending of a receipt notification.

The system of Miller does not provide an E-mail identifying multiple prospective image output devices as recited in independent claim 14. As stated in column 1, lines 54-58 of the Miller patent, "The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network." (emphasis added). This is not the same as the claimed feature.

Independent claim 31 recites a similar E-mail transmitting device as independent claim 14. The Miller patent does not disclose all of the features recited in independent claims 14 and 31.

For at least this reason, the final Office Action fails to show that the Miller patent discloses every element recited in claims 14 and 31. The rejection should be reversed.

B. Rejections under 35 USC §103

The Office has the initial burden of establishing a **factual basis** to support the legal conclusion of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d

1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning with some rational underpinning** to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added).

1. Claims 38, 40 and 42

Independent claims 38, 40 and 42 recite selecting one of multiple image output devices and "sending an E-mail to a certain destination containing a notification of the selected image output device." Thus, a notification email is sent to the destination of an original incoming email that has been received, and this notification email identifies an image output device on which data from the original email is to be output. Independent claim 44 recites a similar notifying feature as independent claims 38, 40 and 42.

In making the rejection of claims 38, 40 and 42 in the Office Action, the Examiner asserts that the claimed sending an E-mail to a destination containing a notification of the selected image output device is disclosed by the Miller patent at column 1, lines 47-58, column 2, lines 58-64, column 5, lines 35-49, column 6, lines 14-19 and column 9, lines 40-46.

The Examiner goes on to explain at page 7, third bullet point, that the Miller patent teaches an environment where e-mail addressed to a mobile subscriber is received at the service controller, a receipt notification is selectively generated and delivered to the addressee and finally the intended e-mail is displayed to the subscriber or output to a device such as a facsimile. The Examiner then quotes a substantial portion of column 3, lines 33-38.

After carefully considering the Examiner's arguments, the characterization of the Miller system, the language quoted from Column 3 of the Miller patent, and the other cited columns and lines, the Appellant was unable to find the claimed feature of

a sending an E-mail to the certain destination containing a notification of the selected image output device in the Miller patent.

The system described in the Miller patent merely sends a receipt notification, nothing more. For example, column 1, lines 47-58, in particular, lines 54-58, state "The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network." (emphasis added). There is no mention of an e-mail containing a notification of the selected image output device being sent to the certain destination. The Miller patent describes a notification acknowledging receipt of a message and delivery of the message to an output device indicated by the subscriber.

Column 2, lines 52-64 describes subsystems and delivery systems that are suitable for implementing the system architecture. Column 5, lines 35-49 describes the process of pressing the content soft key with reference to Figure 4(i).

Column 6, lines 14-19 describe the hypothetical user entering a destination fax number to which a graphics file is to be sent.

Finally, column 9, lines 40-46 discuss that filtering and forwarding rules are flexible, and permit filtering and forwarding of mail messages in any manner capable of being specified as a rule. Again, there is no disclosure or suggestion of sending an e-mail containing a notification of the selected image output device in any of the above citations or in column 3, lines 33-38 of the Miller patent.

In the context of the Miller patent, there is no reason to send an email to the subscriber containing a notification of the image output device selected by the selecting device. In particular, the subscriber uses the menu of Figure 4(j) to choose an image output device X. As such, why would it be necessary to send the subscriber an E-mail informing the subscriber that he or she just chose image output device X?

As stated at page 8 of the Office Action, the Examiner is relying on the Theimer patent for its alleged disclosure of the claimed features of a location information acquiring device and a selecting device. However, the Office Action does not show that the Theimer patent overcomes the deficiencies of the Miller patent outlined above.

The Examiner has not provided a citation in the Theimer patent that discloses the claimed features of preparing receipt notice E-mail based on a received E-mail, transmitting to a certain destination the receipt notice E-mail and sending an E-mail to said destination containing a notification of the selected image output device.

Neither the Miller patent nor the Theimer patent, either individually or in combination, disclose all of the features recited in the independent claims and those that depend therefrom. Appellant respectfully requests that the rejection of claims 38, 40, 42 be reversed.

2. Claims 44-46

Independent claim 44 recites a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail and information on at least one output device to which at least a part of the E-mail is to be outputted, and for controlling the communication interface to send the generated one E-mail to said certain destination. (emphasis added).

The cited portions of the Miller patent, i.e., column 1, lines 47-58, column 2, lines 58-64, column 5, lines 35-49, column 6, lines 14-19 and column 9, lines 40-46, do not disclose a processor for generating at least one E-mail containing information on at least one output device to which at least part of the E-mail is to be output as recited in independent claim 44.

Further, the Examiner has not provided a citation in the Theimer patent that discloses the claimed features of a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail and information on at least one output device to which at least a part of the E-mail is to be outputted, and for controlling the communication interface to send the generated one E-mail to said certain destination.

Regarding the subject matter of claim 45, Miller nor Theimer disclose the claimed feature of an E-mail generated by the processor including information on multiple prospective image output devices, wherein, upon receipt of an E-mail from the certain destination, designating one of the multiple prospective image output

devices, and wherein, the processor sends part of the E-mail to the designated image output device.

As noted above, column 1, lines 54-58 of the Miller patent provide, "The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network." (emphasis added). This is not the same as the claimed feature. Miller's network does not generate an E-mail including information on multiple prospective image output devices nor does it designate one of the multiple prospective image output devices.

Additionally, Miller nor Theimer disclose the claimed subject matter of claim 46 and the Examiner has not provided a citation in either patent that discloses the claimed features.

Neither the Miller patent nor the Theimer patent, either individually or in combination, disclose all of the features recited in the independent claims and those that depend therefrom. Appellant respectfully requests that the rejection of claims 44-46 be reversed.

C. In Conclusion

The Office Action does not meet the requirements of the statutes -- 35 USC 102 or 103 and thus the rejections should be reversed.

VIII. Claims Appendix

See attached Claims Appendix for a copy of the claims involved in the appeal.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix

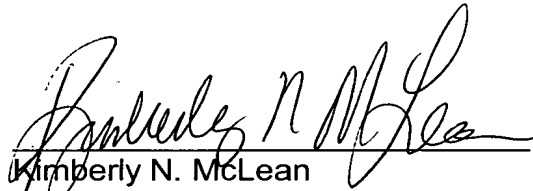
None.

Respectfully submitted,

BUCHANAN INGERSOLL AND ROONEY PC

Date: September 23, 2008

By:


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VIII. CLAIMS APPENDIX

The Appealed Claims

Claim 14. An E-mail controlling apparatus comprising:

an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;

an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;

an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;

an instruction receiving device receiving an E-mail including an instruction for specifying one of multiple image output devices;

a converting device converting the attachment file portion into data of a format acceptable to the image output device; and

a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.

Claim 31. An E-mail controlling system comprising:

an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;

an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;

an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;

an instruction receiving device receiving an E-mail including an instruction specifying one of multiple image output devices;

a converting device converting the attachment file portion into data of a format acceptable to the image output device; and

a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.

Claim 38. An E-mail processing method comprising the steps of:

receiving E-mail addressed to a certain destination;

preparing receipt notice E-mail based on the received E-mail;

transmitting said receipt notice E-mail to said destination;

acquiring location information of said destination;

selecting one of multiple image output devices on the basis of the location information of said destination acquired;

sending an E-mail to said destination containing a notification of the selected image output device; and

transmitting at least a portion of the data of the received E-mail to the selected image output device.

Claim 40. A computer-readable medium having a plurality of sequences of instructions stored thereon including sequences of instructions which are executed by one or more processors to perform the steps of:

receiving E-mail addressed to a certain destination;
preparing receipt notice E-mail based on the received E-mail;
transmitting said receipt notice E-mail to said destination;
acquiring location information of said destination;
selecting one of multiple image output devices on the basis of the location
information of said destination acquired;
sending an E-mail to said destination containing a notification of the selected
image output device; and
transmitting at least a portion of the data of the received E-mail to the selected
image output device.

Claim 42. A program product comprising:
a computer-readable medium; and
computer program contained on said computer-readable medium for causing
a computer to execute a process comprising the steps of:
receiving E-mail addressed to a certain destination;
preparing receipt notice E-mail based on the received E-mail;
transmitting said receipt notice E-mail to said destination;
acquiring location information of said destination;
selecting one of multiple image output devices on the basis of the location
information of said destination acquired;
sending an E-mail to said destination containing a notification of the selected
image output device; and
transmitting at least a portion of the data of the received E-mail to the selected
image output device.

Claim 44. An E-mail controlling apparatus comprising:
a communication interface for sending and receiving E-mails;
a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail and information on at least one output device to which at least a part of the E-mail is to be outputted, and for controlling the communication interface to send the generated one E-mail to said certain destination.

Claim 45. The E-mail controlling apparatus of claim 44, wherein said at least one E-mail generated by the processor includes information on multiple prospective image output devices, and wherein, upon receipt of an E-mail from the certain destination, designating one of the multiple prospective image output devices, the processor sends said part of the E-mail to the designated image output device.

Claim 46. The E-mail controlling apparatus of claim 44, wherein the processor separately generates an E-mail containing said notification of the receipt of the E-mail, and an E-mail containing information on at least one output device to which at least a part of the E-mail is to be outputted.